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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,853	03/23/2004	Neal Hall	204.001US01	2485
27073	7590	07/24/2006	EXAMINER	
LEFFERT JAY & POLGLAZE, P.A. P.O. BOX 581009 MINNEAPOLIS, MN 55458-1009			GORMAN, DARREN W	
			ART UNIT	PAPER NUMBER
			3752	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,853

Applicant(s)

HALL ET AL.

Examiner

Darren W. Gorman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) 13-18, 22-26 and 31-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-6, 8-12, 19-21 and 35 is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 13-18 and 22-26 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** traverse in the reply filed on February 10, 2006.

2. Newly submitted claims 31-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The limitations in newly added claims 31 and 34 are drawn to non-elected species Group II, as identified in the restriction requirement mailed November 1, 2005. It should also be noted that the claims elected by original presentation for prosecution on the merits did not include a generic claim.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-34 are also withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Further, it should be noted that newly added claims 31-33 are recited to be dependent on a canceled claim (claim1).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Linsalato et al., USPN 3,907,037.

Linsalato shows a fire extinguisher (see Figure 2) comprising: a container (20) containing a pressurized fire retardant (54); a delivery tube (30 or 32) connected to the container and in fluid communication with the pressurized fire retardant; and a fusible tip (38 or 40, each of which comprise fusible material 72) disposed at a distal end (74, 78) of the delivery tube that seals the delivery tube (see Figure 5), and which, upon melting of the fusible tip when the fusible tip is exposed to a temperature that exceeds its melting temperature, permits expulsion of the pressurized fire retardant from the container and through the distal end of the delivery tube (see column 3, lines 25-48).

As to the preamble, which recites an “appliance fire extinguisher”, it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

Further, as to the recitations, “wherein the distal end is disposable within the appliance and wherein the fusible tip is adapted to release the fire retardant from the container into the appliance”, such recitations are considered functional language. Since the aforementioned functional recitations do not further limit the claimed structure of the device, these recitations

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have been given patentable weight in as much as the prior art reference structure is capable of performing the claimed function.

Also, as to the recitation, “wherein the container is adapted to be recharged”, Linsalato shows a filling tube (50) disposed on the container, which is used for filling/charging the container (see Figure 4; and column 2, lines 48-60). Though the device of Linsalato is described as being “disposable”, there is nothing that would preclude the user from recharging the container via the filling tube after the device has been used at least once.

Allowable Subject Matter

5. Claims 2-6, 8-12, 19-21 and 35 are allowed.

Response to Arguments

6. Applicant's arguments filed on page 11 of the “Remarks” section of Applicant's response filed July 7, 2006, with respect to the rejection of claim 7 under 35 U.S.C. 102(b), as being anticipated by Linsalato et al. (US Patent No. 3,907,037), have been fully considered but they are not persuasive.

It is Applicant's argument that since the device shown by Linsalato is expressly disclosed as being “disposable”, then the device not “rechargeable”. As further “evidence” of not being rechargeable, Applicant argues that the filling tube (50) of Linsalato is pinched off and sealed after the extinguisher container is filled.

As set forth above under paragraph 4 of this office action, and as substantially repeated from paragraph 5 of the office action mailed March 7, 2006, it is the Examiner's position that

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although the device of Linsalato is described as being “disposable”, there is nothing that would preclude the user from recharging the container via the filling tube after the device has been used at least once. Further, the fact that the filling tube (50) is pinched off and sealed after the container is filled does not necessarily and definitively mean that one is precluded from refilling/recharging the container after the extinguishing material is released. Absent any expressed disclosure that the container cannot be refilled, it is reasonable to expect that one can un-seal and un-pinch the tube, thereby permitting recharging of the container. Further, it is the Examiner’s position that the concept of the filling tube being pinched off and sealed after filling is irrelevant to the idea that the container of the device is “adapted to be recharged”. In other words, if the filling tube of Linsalato were not sealed after filling, then one would reasonably expect that the pressure of the extinguishing material held within the container would leak out through the filling tube, thereby rendering the device completely inoperable as disclosed.

Further, the container of the apparatus of claim 7 is recited as being, “adapted to be recharged”. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. As set forth above, the device of Linsalato clearly has the ability to perform the recited function.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Gorman whose telephone number is 571-272-4901. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on 571-272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DWG 7/19/06
DWG
July 19, 2006

Darren W Gorman
Examiner
Art Unit 3752

Dinh Q. Nguyen
DINH Q. NGUYEN
PRIMARY EXAMINER